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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of : **Confirmation No. 6961**
Kenji TAGAWA et al. : Docket No. 99_1229A
Serial No. 09/436,656 : Group Art Unit 3627
Filed November 9, 1999 : Examiner G. J. O'Connor
DATA CONVERSION APPARATUS Mail Stop: Appeal Brief-Patents
AND METHOD IN COPYRIGHT
PROTECTING SYSTEM

APPELLANTS' AMENDED APPEAL BRIEF IN RESPONSE TO
NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Non-Complaint Appeal Brief dated May 2, 2006, Appellants submit herewith an Amended Appeal Brief under the provisions of 37 CFR 41.37 in connection with the above-identified application.

In the Amended Appeal Brief, the "Grounds of Rejection to be Reviewed on Appeal" section does not include the term "whether", as requested by the Examiner. Accordingly, the Amended Appeal Brief is deemed to be fully response to the Notification.

The USPTO is directed and authorized to charge all required fees (except the Issue/Publication Fees) to Deposit Account No. 23-0975.

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEES FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975

REAL PARTY IN INTEREST

The real party in interest is MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD., the assignee of record.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

Claims 1-21, 25 and 29-42 have been canceled.

Claims 49-54 have been withdrawn from consideration.

Claims 22-24, 26-28 and 43-48 stand finally rejected.

The Appellants now appeal the rejection of claims 22-24, 26-28 and 43-48.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the final Office Action of April 7, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

A description of the subject matter of the rejected claims is presented below with reference to the written description and drawings of this application.

The subject matter of independent claims 22 and 43 is directed to a data conversion apparatus of a copyright protecting system, wherein the data conversion apparatus is operable to convert received audio data to the same format as that of network distribution data so that the data format can be standardized in the processing to thereby protect a copyright of non-ciphered audio data (e.g., non-superdistribution format) as well as ciphered data (e.g., superdistribution format) (see col. 1, lines 6-17).

As shown in Fig. 1, a data conversion apparatus 101 includes a data transmission/reception portion 102 that is able to receive data distributed both via the Internet and via a disc medium such as a compact disc (see page 13, lines 4-9; page 14, lines 2-4; and page 20, lines 14-16). After data is received by the data transmission/receiving portion 102, a data format judging portion 103 judges whether or not the received data is of a superdistribution format 103 (see page 14, line 14 through page 15, line 1, and page 23, lines 7-11). As

explained on page 16, lines 2-13, the term “superdistribution” refers to distribution data ciphered to an AAC (Advanced Audio Coding) format including attribute information such as at least charge information.

If it is determined by the data format judging portion 103 that the received data is obtained via a medium such as a compact disc, an attribute information adding unit 105 obtains attribute information (e.g., a user ID 201, IRC information 202, copy control information 203, ciphering information 204, charge information 205 and a contents deciphering key 206) from a database of an external computer, and adds this attribute information to the audio data (see page 19, lines 6-10; and page 24, line 20 through page 25, line 8).

The received audio contents together with the obtained attribute information, under the control of a controller 115, is then converted to a superdistribution format via a data compression conversion portion 104, the attribute information adding unit 105 and a first ciphering unit 106 (see page 25, lines 8-13; and page 25, line 24 through page 26, line 4).

Data in the superdistribution format has a user ID added thereto by the user ID adding unit 107, which has the user ID supplied by a user ID generation storage section 114, and then the contents 207 together with the attribute information 201 to 206 is recorded on a primary recording medium 109 via a first recording unit 108 (see page 26, lines 13-18).

Thus, according to the present invention, data obtained from a medium such as a compact disc is able to be converted to the same data format as that of superdistribution data that is distributed via the Internet (see page 26, lines 18-21 and page 30, lines 8-14). Accordingly, by providing the ability to convert data obtained from a medium such as a compact disc to the same format (i.e., the superdistribution format) as data distributed via the Internet, a standardized data format is provided, thereby providing the ability to protect the copyright of data received from the Internet as well as data received from a medium such as a compact disc (see page 1, lines 12-17).

In addition to the above summary, for each independent claim and each dependent claim argued separately, Appellants provide the following indication of the means plus function limitations along with a description of the corresponding element described in the specification:

Claim 43:

A. A data transmission/receiving means for transmitting and receiving data to and from the external equipment. The data transmission/receiving means corresponds to the data transmission/receiving portion 102 of Fig. 2 (see page 14, line 24 through page 15, line 1).

B. A data format judging means for judging whether or not data received by said data transmission/receiving means is of a superdistribution format. The data format judging means corresponds to the data format judging section 103 of Fig. 2 (see page 23, lines 7-11).

C. An attribute information obtaining means for identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via said data transmission/receiving means. The attribute information obtaining means corresponds to the attribute information adding unit 105 of Fig. 2 (see page 25, lines 3-8).

D. A user ID storage means for storing the identification information identifying the user of the data conversion apparatus. The user ID storage means corresponds to the user ID generation storage portion 114 of Fig. 2 (see page 23, lines 15-22).

E. A ciphering means for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means. The ciphering means corresponds to the first ciphering unit 106 of Fig. 2 (see page 26, lines 9-11).

F. A data format conversion means for adding said ciphered attribute information and identification information to the audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution data format. The data format conversion means corresponds to the data compression conversion portion 104, the attribute information adding unit 105 and the first ciphering unit 106 of Fig. 2 (see page 25, lines 8-13).

G. A controlling means for controlling said data transmission/receiving means, data format judging means, attribute information obtaining means and data format conversion means. The controlling means corresponds to the controller 115 of Fig. 2 (see page 25, line 24 through page 26, line 8).

H. In a case where said data format judging means judges that the received data is not of the superdistribution format, said controlling means controls said attribute information

obtaining means so as to obtain the attribute information corresponding to the audio contents from the external equipment, and wherein said controlling means controls said data format conversion means so as to convert the audio contents of the received data together with the obtained attribute information into the superdistribution format data, so that the resultant data converted to the superdistribution data format is outputted and supplied to the external recording apparatus. The data format judging means corresponds to the data format judging section 103 of Fig. 2 (see page 23, lines 7-11), the controlling means corresponds to the controller 115 of Fig. 2 (see page 25, line 24 through page 26, line 8), and the attribute information obtaining means corresponds to the attribute information adding unit 105 of Fig. 2 (see page 25, lines 3-8).

I. The attribute information obtaining means obtains identification information read out of the disc medium and transmits the obtained information to the external server via the digital network and receives attribute information corresponding to the audio contents recorded in the disc medium identified by the identification information from the external server. The attribute information obtaining means corresponds to the attribute information adding unit 105 of Fig. 2 (see page 25, lines 3-8).

Claim 44:

A. A data outputting means, wherein in a case where said data format judging means judges that the received data is of the superdistribution format, said controlling means controls said data outputting means so as to supply the received superdistribution format data to the external recording apparatus. The data outputting means corresponds to the data output portion 112 of Fig. 2 (see page 29, line 23 to page 30, line 2), and the controlling means corresponds to the controller 115 of Fig. 2 (see page 25, line 24 through page 26, line 8).

Claim 45

A. A recording means for recording the superdistribution format data. The recording means corresponds to the first recording unit 108 and the primary recording medium 109 of Fig. 2 (see page 23, lines 20-22).

B. A charging means for executing a charging operation based on the charge condition of the attribute information wherein said controlling means controls said charging

means so as to execute the charging operation of the superdistribution format data based on the charge condition of the attribute information when a copy of the superdistribution format data read out of said recording means is supplied to the external recording apparatus to be recorded therein. The charging means corresponds to the charging portion 113 of Fig. 2 (see page 29, lines 17-22), and the controlling means corresponds to the controller 115 of Fig. 2 (see page 25, line 24 through page 26, line 8).

C. The controlling means controls the charging means so as to execute the charging operation of the superdistribution format data based on the charge condition of the attribute information when a copy of the superdistribution format data read out of said recording means is supplied to the external recording apparatus to be recorded thereon. The controlling means corresponds to the controller 115 of Fig. 2 (see page 25, line 24 through page 26, line 8), the charging means corresponds to charging portion 113 of Fig. 2 (see page 29, lines 17-22), and the recording means corresponds to the first recording unit 108 and the primary recording medium 109 of Fig. 2 (see page 23, lines 20-22).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 22-24, 26-28 and 43-48 are rejected under 35 U.S.C. § 102(e) as being anticipated by Imai et al. (U.S. Patent No. 5,870,467).

ARGUMENT

I. Rejection of claims 22-24, 26-28 and 43-48 under 35 U.S.C. § 102(e) over U.S. Patent No. 5,870,467 to Imai et al. (hereinafter “Imai”)

Summary of Imai

Imai discloses an input/output management apparatus 10 for controlling data input and data output to and from an input/output requesting program 11 (see Fig. 2 and col. 8, lines 15-18). As shown in Fig. 2 of Imai, the input/output management apparatus 10 comprises a data input/output request reception unit 1 for receiving data input/output requests from the program 11; a data input unit 2 for entering data into the program 1 via the input/output request reception unit 1; a protected data judgement unit 3 for judging whether each data input entered into the program 11 is a protected data or not; a protected data input recording unit 4

for recording each input of the protected data detected by the protected data judgement unit 3; an output permission judgement unit 5 for judging whether data output from the program 11 requested via the input/output request reception unit 1 is permitted or not according to the input of the protected data recorded in the protected data input recording unit 4; and a data output unit 6 for outputting data from the input/output requesting program 11 which is judged to be permitted by the output permission judgement unit (see Figs. 1 and 25; and col. 8, lines 18-34).

The data input/output management apparatus 10 of Imai described above operates according to the flowchart as shown in Fig. 2. In particular, as shown in steps S21 and S22 of Fig. 2, when the input/output requesting program 11 issues a request for data input/output, the input/output request reception unit 1 receives this request, and judges an ID of the request program 11 and a type of the request (i.e., whether the request is for data input or for data output) (see col. 8, lines 39-44).

If it is judged at the input/output request reception unit 1 that the received request is a data input request, the data input unit 2 reads out the requested data from the recording medium (see step S23 in Fig. 2; and col. 8, line 65 through col. 9, line 3). After the requested data has been read by the data input unit 2, the protected data judgement unit 3 then judges whether the requested input data is a protected data or not by examining the header of the data (see step S24 in Fig. 2; and col. 9, lines 9-10).

As explained in Imai, the protected data judgement unit 3 of Imai is able to determine whether a piece of data is protected or not based on either (1) the header of the data, (2) the name of the file in which the data is contained, or (3) according to a recording position of the data in a recording medium (see col. 9, lines 8-16).

If the data judgement unit 3 determines that the data is protected, a record of the input is made in the protected data input recording unit 4 by storing an ID of the requesting program 11 in the protected data input recording unit 4 (see step S23 of Fig. 2; and col. 9, lines 42-55). In contrast, if the data is not determined to be protected, then no record is made in the protected data input recording unit 4 (see col. 9, lines 45-48). Next, the requested data is transferred to the input/output requesting program 11 (see step S26 of Fig. 2; and col. 9, lines 64-65). This completes the data input request (see End step of Fig. 2).

On the other hand, when a data output request is received at the input/output request reception unit 1, the output permission judgment unit 5 checks whether the ID of the requesting program 11 is stored in the protected data input recording unit 4 (see Step S27 of Fig. 2; and col. 10, lines 10-16).

If the ID is not stored in the protected data input recording unit 4, then the data is output (see step S28 of Fig. 2; and col. 10, lines 16-20). However, if the ID is stored in the protected data input recording unit 4, this implies that the requesting program 11 has previously read protected data, and therefore, whether the data can be output is based on the type of requested output target (see col. 10, lines 22-27). For example, when the requested output target is an output device such as a display device from which the data cannot be directly read by another program, the data output request is permitted and the requested data is output to the specified output target (see steps S29, S30 and S31 of Fig. 2; and col. 10, lines 27-30). Conversely, if it is determined that the output target is not a display device, the data output request is refused because there is a possibility that protected data will be duplicated (see Step S31 of Fig. 2; and col. 10, lines 31-33).

Thus, as is evident from the above description of Imai, for a requesting program 11 that has not read any form of protected data, the data input/output management apparatus permits data output from the program 11 without any restriction (see col. 10, lines 37-39). Conversely, for a requesting program that has read at least one piece of protected data, a data output is permitted only to an output target such as a display device, and a data output to any other target is prohibited (see col. 10, lines 39-43). As a result, the data input/output management apparatus 10 of Imai is able to eliminate the possibility of protected data being duplicated, without limiting data output operations for any program 11 that has not read any protected data (see col. 10, lines 43-46).

A. Claims 22 and 26-28

Initially, Appellants note that on page 3 of the final Office Action, the Examiner asserts that “the extensively recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight, as the apparatus of Imai et al. is inherently capable of performing the recited functions” (emphasis added).

First, Appellants disagree with the Examiner's position that the functional language recited in the claims is a mere "intended usage" of the claimed invention which can be afforded little patentable weight. Instead, Appellants submit that the functional language set forth in the claims describes the functions of the elements recited in the claimed apparatus, and further, as explained in MPEP § 2173.05(g), it is well settled that a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.

Second, Appellants disagree with the Examiner's position that the apparatus of Imai is inherently capable of performing the recited functions set forth in the claims. Appellants submit that the Examiner has not provided a factual basis to support such a position. In this regard, Appellants note that the "fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." See MPEP §2112 (IV)(emphasis in original).

Further, as explained in the MPEP, when "relying on a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." See MPEP §2112 (IV)(emphasis in original).

Contrary to the position taken by the Examiner, Appellants submit that the structure in Imai is not inherently capable of performing the functional features recited in claim 22. Items 1-6 below discuss in detail the features of claim 22 which Appellants submit are not inherent to Imai. Regarding claims 26-28, Appellants note that these claims depend from claim 22 and are therefore patentable at least by virtue of their dependency.

1. Claim 22 recites the feature of a data format judging section for judging whether or not data received by said data transmission section is of a superdistribution data format.

In the final Office Action, the Examiner has taken the position that the data judgement unit 3 of Imai corresponds to the data format judging section as claimed (see final Office Action at page 4). In other words, the Examiner has taken the position that the data judgement unit 3 of Imai is inherently capable of judging whether or not data is of a superdistribution format. Appellants disagree.

In particular, as discussed in the above summary of Imai, the protected data judgement unit 3 is responsible for determining whether a piece of data is protected or not, by examining, for example, the header of the data to determine whether the header is of a prescribed format (see col. 9, lines 13-16). Thus, while the protected data judgement unit 3 of Imai is able to determine whether data is protected or not, Appellants submit that the protected data judgement unit 3 is not disclosed as being able to judge whether or not data is of a superdistribution format.

In item 8 on page 5 of the final Office Action, the Examiner appears to take the position that the protected data of Imai is “superdistribution data”. Appellants note, however, that the term superdistribution is a term well known in the art, and further, that the specification has provided an explicit definition for superdistribution data. In particular, the specification at page 16, lines 2-13, sets forth that the term “superdistribution” means distribution data ciphered to an AAC (Advanced Audio Coding) format including attribute information such as at least charge information.

Accordingly, as Imai does not disclose that the protected data that is input to the data judgement unit 3 is of a superdistribution format (i.e., distribution data ciphered to an AAC format including attribute information such as at least charge information), Appellants submit that the Examiner’s position that the protected data judgement unit 3 of Imai is inherently capable of judging whether or not data is of a superdistribution format is incorrect.

In addition, Appellants note that while the Background of the Invention section of Imai mentions the use of a superdistribution concept at col. 2, lines 54-65, that this is the only mention in Imai of superdistribution, and that Imai does not in any way disclose or suggest that the protected data judgement unit 3 is capable of detecting whether data is of a superdistribution format.

Accordingly, for at least the above noted reasons, Appellants submit that the Examiner is incorrect in asserting that the protected data judgement unit 3 of Imai is inherently capable of detecting whether data is of a superdistribution format.

- 2. Claim 22 recites the feature of an attribute information obtaining section for identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section.**

In the final Office Action, the Examiner has taken the position that the protected data input recording unit 4 of Imai corresponds to the attribute information obtaining section as claimed (see final Office Action at page 4). In other words, the Examiner has taken the position that the protected data input recording unit 4 of Imai is inherently capable of identifying audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section. Appellants disagree.

In particular, as discussed in the above summary of Imai, if a data input request is received at the input/output request reception unit 1, the data input unit 2 reads out the requested data from a recording medium (see step S23 in Fig. 2; and col. 8, line 65 through col. 9, line 3). After the requested data has been read by the data input unit 2, the protected data judgement unit 3 then judges whether the requested input data is a protected data or not by examining the header of the data (see step S24 in Fig. 2; and col. 9, lines 9-10).

If the data judgement unit 3 determines that the data is protected, a record of the input is made in the protected data input recording unit 4 by storing an ID of the requesting program 11 in the protected data input recording unit 4 (see step S23 of Fig. 2; and col. 9, lines 42-55). In contrast, if the data is not determined to be protected, then no record is made in the protected data input recording unit 4 (see col. 9, lines 45-48).

Subsequently, when a data output request is received at the input/output request reception unit 1, the output permission judgment unit 5 checks whether the ID of the requesting program 11 is stored in the protected data input recording unit 4 (see Step S27 of Fig. 2; and col. 10, lines 10-16). If the ID is not stored in the protected data input recording unit 4, then the data is output (see step S28 of Fig. 2; and col. 10, lines 16-20). However, if the ID is stored in the protected data input recording unit 4, this implies that the requesting program 11 has previously read protected data, and therefore, whether the data can be output is based on the type of requested output target (see col. 10, lines 22-27).

Thus, based on the foregoing description of the protected data input recording unit 4, it is clear that while the protected data input recording unit 4 of Imai is capable of storing an ID of the requesting program 11 if it is determined that the data input to the data input unit 2 is protected, that there is absolutely no disclosure or suggestion in Imai that the protected data

input unit 4 of Imai is inherently capable of identifying audio contents of the data and obtaining attribute information corresponding to the identified audio contents from external equipment via a data transmission/receiving section, as recited in claim 22.

In item 14 on page 7 of the final Office Action, the Examiner provides an explanation as to how the protected data input unit 4 of Imai is inherently capable identifying audio contents of the data and obtaining attribute information corresponding to the identified audio contents from external equipment via a data transmission/receiving section.

In particular, with respect to the alleged inherent ability of the protected data input recording unit 4 to identify audio contents of the data, the Examiner asserts that the protected data input recording unit 4 of Imai necessarily identifies the audio contents of the data because it necessarily ascertains that the data is digital data in a recognizable, coherent, useable format, as opposed to random data.

Appellants note, however, that even if the protected data input recording unit 4 of Imai is able to recognize the difference between digital data and background noise, as suggested by the Examiner, that the mere ability to recognize digital data does not in any way suggest that that the protected data input recording unit 4 is inherently capable of recognizing audio contents of the data.

Further, with respect to the alleged inherent ability of the protected data input recording unit 4 to obtain attribute information corresponding to the identified audio contents from the external equipment via the data transmission/receiving section, the Examiner asserts that the protected data input recording unit 4 is able to obtain attribute information such as the size of a file and the reception rate corresponding to the identified audio contents from external equipment via a data transmission/receiving section. Appellants disagree.

First, Appellants note that the Examiner has provided no evidence that the protected data input recording unit 4 would be inherently capable of obtaining information such as the size of a file and the reception rate. Indeed, as the protected data input recording unit 4 is merely utilized to store an ID of the requesting program 11 if it is determined that the data input to the data input unit 2 is protected, Appellants submit that the ability to ascertain the size of a file and the reception rate would not be inherent to the protected data input recording unit 4.

Second, as the protected data input recording unit 4 is merely responsible for storing an ID of a requesting program 11, Appellants submit that the protected data input recording unit 4 is clearly not inherently capable of obtaining attribute information corresponding to identified audio contents.

Accordingly, for at least the above noted reasons, Appellants submit that the Examiner is incorrect in asserting that the protected data input recording unit 4 of Imai is inherently capable of identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section.

3. Claim 22 recites the feature of a user ID storage section storing identification information identifying the user of the data conversion apparatus.

As shown on page 4 of the final Office Action, the Examiner recognizes that Imai does not explicitly disclose a user ID storage section storing the identification information identifying the user of the data conversion apparatus. Nonetheless, the Examiner alleges that a user ID storage section as claimed must be inherently present in Imai in order to perform the disclosed “authentication” as shown, for example, in Fig. 14 of Imai. Appellants disagree.

In particular, Appellants note that the “authentication” referred to by the Examiner relates to the authentication of an application program, not to the authentication of a user of the apparatus. For example, as explained at col. 17, lines 55-58 of Imai, the authentication of an application program is carried out by using a digital signature scheme. In addition, Appellants note that at col. 19, lines 11-18 of Imai, it is disclosed that at a time of execution of the application program 106, a copyright kernel 104 deciphers the enciphered file of the application program, and when the deciphering is successfully completed, it implies that the application program 106 is correctly authenticated.

Thus, as explained above, while Imai is capable of authenticating an application program 106, there is absolutely no suggestion in Imai of a process for authenticating a user of the apparatus. Therefore, as the authentication process in Imai relates to the authentication of application program 106, Appellants submit that the feature of a user ID storage section

storing identification information of the user of the data conversion apparatus is clearly not inherent to Imai.

In this regard, however, the Examiner asserts at item 16 on page 8 of the final Office Action that the authentication of the application program *is* the identification information of the user because the two are uniquely and inseparably associated and logically attached, and therefore, that the apparatus of Imai includes a user ID storage section storing identification information of the user. Further, the Examiner asserts that the claim does not require the actual name of the individual operating the system, but reads merely on storing any information that serves to identify the user.

In response, Appellants submit that, contrary to the position taken by the Examiner, the authentication of the application program 106 in Imai cannot in any way be considered as the identification information of a user of the apparatus of Imai. That is, the authentication of the application program 106 of Imai relates solely to the application program itself, and does not disclose that any information regarding a user is required to perform the authentication of the application program.

Further, while the Examiner is correct in stating that the claim does not require the actual name of the individual operating the system, Appellants submit that the authentication of the application program 106 does not include any information relating to the user of the apparatus of Imai, and moreover, Appellants note that not all devices require a user to identify themselves by a user ID.

Accordingly, as Imai does not disclose that any information pertaining to a user is necessary for the authentication of the application program 106, Appellants submit that Imai does not inherently include a user ID storage section storing identification information identifying the user of the data conversion apparatus, as recited in claim 22.

4. Claim 22 recites the feature of a ciphering section ciphering the attribute information obtained from the external equipment and the identification information stored in the user ID storage section.

In the final Office Action, the Examiner has taken the position that the sub hardware 132 as shown in Fig. 20 of Imai corresponds to the ciphering section as claimed (see final Office Action at page 4). In other words, the Examiner has taken the position that the sub

hardware 132 of Imai is inherently capable of ciphering the attribute information obtained from the external equipment and the identification information stored in the user ID storage section. Appellants disagree.

Regarding the sub hardware 132 of Imai, Appellants note that the sub hardware 132 is shown in Fig. 20 as having the ability to communicate using cipher communication in order to protect transmitted data (see col. 18, lines 46-48). Thus, while the sub hardware 132 of Imai is capable of performing cipher communication, Appellants submit that the mere ability to perform cipher communication does not in any way suggest that the sub hardware 132 is inherently capable of ciphering attribute information obtained from external equipment and identification information stored in a user ID storage section, as recited in claim 22.

Indeed, the Examiner has not provided any factual basis as to how or why the ability to cipher attribute information obtained from external equipment and identification information stored in a user ID storage section would be inherent to the sub hardware 132 of Imai. In view of the foregoing, Appellants submit that the Examiner is incorrect in asserting that the sub hardware 132 of Imai is inherently capable of ciphering attribute information obtained from external equipment and identification information stored in a user ID storage section.

5. Claim 22 recites the feature of a data format conversion section adding said ciphered attribute information and identification information to the audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution format.

In the final Office Action, the Examiner has taken the position that the output permission judgement unit 5 corresponds to the data format conversion unit as claimed (see final Office Action at page 4). In other words, the Examiner has taken the position that the output permission judgement unit 5 of Imai is inherently capable of adding ciphered attribute information and identification information to audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution format. Appellants disagree.

In particular, as discussed in the above summary of Imai, the output permission judgement unit 5 of Imai is responsible for judging whether data output from the program 11

requested via the input/output request reception unit 1 is permitted or not according to the protected data recorded in the protected data input recording unit 4 (see col. 10, lines 10-26).

Thus, based on the foregoing description of the output permission judgement unit 5 of Imai 4, it is clear that while the output permission judgement unit 5 is capable of determining whether data output is permitted, Appellants submit that the output permission judgement unit is in no way whatsoever capable of adding ciphered attribute information and identification information to audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution format, as recited in claim 22.

In view of the foregoing, Appellants submit that the Examiner is incorrect in asserting that the output permission judgement unit 5 of Imai is inherently capable of adding ciphered attribute information and identification information to audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution format.

6. **Claim 22 recites that in a case where said data format judging section judges that the received data is not of the superdistribution format, said controller controls said attribute information obtaining section so as to obtain the attribute information corresponding to the audio contents from the external equipment, and wherein said controller controls said data format conversion section so as to convert the audio contents of the received data together with the obtained attribute information into the superdistribution format data, so that the resultant data converted to the superdistribution data format is outputted and supplied to the external recording apparatus.**

Appellants note that the Examiner has not addressed the above-noted functional features of claim 22 in the Final Office Action. To extent that the Examiner taking the position that the structure of Imai is inherently capable of performing such functional features, Appellants disagree.

As discussed above, in Imai, for a requesting program 11 that has not read any form of protected data, the data input/output management apparatus 10 permits data output from the program 11 without any restriction (see col. 10, lines 37-39). Conversely, for a requesting program that has read at least one piece of protected data, a data output is permitted only to an output target such as a display device, and a data output to any other target is prohibited (see col. 10, lines 39-43).

Appellants submit, however, that while Imai discloses a data input/output management apparatus that protects against protected data being duplicated, that the data input/output management apparatus of Imai is not inherently capable of operating such that in a case where a data format judging section judges that the received data is not of the superdistribution format, a controller controls an attribute information obtaining section so as to obtain the attribute information corresponding to the audio contents from external equipment, and wherein the controller controls a data format conversion section so as to convert the audio contents of the received data together with the obtained attribute information into the superdistribution format data, so that the resultant data converted to the superdistribution data format is outputted and supplied to the external recording apparatus, as recited in claim 22.

B. Claim 23

Claim 23 depends from claim 22 and is therefore considered patentable at least by virtue of its dependency. In addition, claim 23 sets forth the feature of a data outputting section, wherein in a case where said data format judging section judges that the received data is of the superdistribution format, said controller controls said data outputting section so as to supply the received superdistribution format data to the external recording apparatus.

In the final Office Action, the Examiner has taken the position that the data output unit 6 of Imai corresponds to the data outputting section as claimed (see final Office Action at page 4). In other words, the Examiner has taken the position that the data output unit 6 of Imai is inherently capable of supplying the received superdistribution format data to the external recording apparatus in a case where said data format judging section judges that the received data is of the superdistribution format. Appellants disagree.

As discussed in the above summary of Imai, the data output unit 6 is able to output data dependent on a judgement by the output permission judgement unit 5 (see col. 10, lines 10-26). Thus, while the data output unit 6 of Imai is able to output data, Appellants submit that Imai does not include any disclosure that would suggest that the data output unit 6 is inherently capable of supplying received superdistribution format data to an external recording apparatus in a case where said data format judging section judges that the received data is of the superdistribution format.

C. Claim 24

Claim 24 depends from claim 22 and is therefore considered patentable at least by virtue of its dependency. In addition, claim 24 sets forth the feature of a charging section for executing a charging operation based on the charge condition of the attribute information.

In the final Office Action, the Examiner has taken the position that the copyright kernel 104 of Imai corresponds to the charging section as claimed (see final Office Action at page 4). In other words, the Examiner is taking the position that the copyright kernel 104 of Imai is inherently capable of executing a charging operation based on a charge condition of the attribute information. Appellants disagree.

In particular, Appellants note that the copyright kernel 104 of Imai is responsible for authenticating the application program 106 by determining whether it is a registered application program or not (see col. 18, lines 18-20). Appellants submit, however, that there is absolutely no disclosure whatsoever in Imai regarding the copyright kernel 104 being able to execute a charge operation based on a charge condition of the attribute information, as recited in claim 24.

Indeed, Appellants note that the Examiner has not come forward with any factual basis as to how the copyright kernel 104 of Imai could arguably be inherently capable of performing a charge operation, but instead, has merely maintained the position in the final Office Action that the copyright kernel 104 corresponds to a charging section as claimed.

D. Claims 43 and 46-48

Regarding claim 43, Appellants note that this claim is similar to claim 22 discussed above, but is written in means plus function format.

Initially, in item 22 on page 10 of the final Office Action, Appellants note that the Examiner asserts that the functional portion of the means-plus-function limitations in claim 43 is mere intended usage.

For example, in item 22 on page 10 of the final Office Action, the Examiner alleges that in claim 43, the limitation which sets forth “a ciphering means for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means” includes structure (i.e., “a ciphering means”) as well as an intended usage of the structure (i.e., “for ciphering the attribute information obtained from the

external equipment and the identification information stored in said user ID storage means"). Appellants submit that the Examiner's interpretation of the means-plus-function clauses of claim 43 is incorrect.

Appellants note that the Federal Circuit has explained that in identifying the function of a means-plus-function limitation, the function cannot be improperly broadened by ignoring the clear limitations contained in the claim language, but instead, the function of a "means plus function" claim must be construed to include the limitations contained in the claim language. See Lockheed Martin Corporation v. Space Systems/Loral, 324 F.3d 1308, 1319, 66 USPQ2d 1282, 1290 (Fed. Cir. 2003).

Based on the foregoing, it is clear that the Examiner's indication of "intended use" language in the means-plus-function clauses is actually the "function" of the means-plus-function limitation. Further, based on the above discussion, Appellant submits that it is plainly evident that the "function" of the means-plus-function clauses in claim 43 must be construed to include the limitations contained in the claim language.

Thus, using the example that the Examiner provided on page 10 of the final Office Action regarding the means-plus-function limitation which recites "a ciphering means for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means", the function of this means plus function limitation is "for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means."

Moreover, in item 22 on page 10 of the final Office Action, the Examiner takes the position that the functional portion of the means plus function limitations does not need to be explicitly disclosed in the reference if the claimed structure, as disclosed in the reference, is inherently capable of performing the claimed usage.

In other words, the Examiner does not believe that a prior art reference must disclose the identical function recited in the means-plus-function limitation. Instead, the Examiner believes that the structure in the prior art must merely be capable of performing the specified function in the mans-plus-function limitation. Appellants disagree.

In particular, Appellants note that MPEP § 2182 sets forth the following with respect to the "functional" portion of means-plus-function limitations:

Both before and after *Donaldson*, the application of a prior art reference to a means or step plus function limitation **requires that the prior art element perform the identical function specified in the claim** (emphasis added).

Thus, as is clear from the MPEP with reference to In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), it is necessary that the prior art structure perform the identical function recited in the means plus function limitation, and if the identical function is not performed, then the prior art cannot be considered anticipatory. Accordingly, as the Examiner has merely taken the position that the prior art structure of Imai is inherently capable of performing the functions recited in claim 43, Appellants submit that the Examiner's rejection is clearly improper.

Moreover, Appellants note that the Examiner also states in item 22 on page 10 of the final Office Action that even if defined in means-plus-function format, apparatus claim limitations are still drawn to structure, and the structure in a reference, to be anticipatory, can either be the same as, or equivalent to, the disclosed structure of the claimed invention.

As noted above, the application of a prior art reference to a means plus function limitation requires that the prior art element perform the identical function specified in the claim (see MPEP 2182). Accordingly, as the structure in Imai clearly does not perform the identical functions recited in the functional portion of the means plus function limitations of claim 43, Appellants respectfully submit that the Examiner's rejection of claim 43 cannot stand.

In this regard, Appellants submit that Imai does not disclose or suggest the functional portions of at least the following means plus function limitations recited in claim 43: a data format judging means for judging whether or not the received data is of a superdistribution format; an attribute information obtaining means for identifying audio contents of the received data and obtaining attribute information corresponding to the identified audio contents from external equipment; a user ID storage means for storing identification information identifying a user of the data conversion apparatus; a ciphering means for ciphering the attribute information obtained from the external equipment and the stored identification information; and a data format conversion means for adding the ciphered attribute information and identification information to the audio contents and thereby

converting the audio contents together with the obtained attribute information to the superdistribution data format.

As noted above in the summary of Imai, for a requesting program 11 that has not read any form of protected data, the data input/output management apparatus 10 permits data output from the program 11 without any restriction (see col. 10, lines 37-39). Conversely, for a requesting program that has read at least one piece of protected data, a data output is permitted only to an output target such as a display device, and a data output to any other target is prohibited (see col. 10, lines 39-43).

Thus, while Imai discloses a data input/output management apparatus that protects against protected data being duplicated, Appellants respectfully submit that Imai does not disclose the identical functions as recited in the above-noted means plus function limitations of claim 43.

Regarding claims 46-48, Appellants note that these claims depend from claim 43 and are therefore considered patentable at least by virtue of their dependency.

E. Claim 44

Regarding claim 44, Appellants note that this claim is similar to claim 23 discussed above, but is written in means plus function format. In particular, claim 44 recites the feature of a data outputting means, wherein in a case where said data format judging means judges that the received data is of the superdistribution format, said controlling means controls said data outputting means so as to supply the received superdistribution format data to the external recording apparatus.

As noted above, in item 22 on page 10 of the final Office Action, the Examiner takes the position that the functional portion of means plus function limitations does not need to be explicitly disclosed in the reference if the claimed structure, as disclosed in the reference, is inherently capable of performing the claimed usage.

For the reasons discussed above with respect to claim 43, Appellants disagree and submit that the prior art structure must perform the identical function recited in the means plus function limitation, and if the identical function is not performed, then the prior art cannot be considered anticipatory. Accordingly, as the Examiner has merely taken the position that the

prior art structure of Imai is inherently capable of performing the functions recited in claim 44, Appellants submit that the Examiner's rejection is clearly improper.

Further, in the final Office Action, the Examiner has taken the position that the data output unit 6 of Imai corresponds to the data outputting means as claimed (see final Office Action at page 4). As discussed in the above summary of Imai, the data output unit 6 is able to output data dependent on a judgement by the output permission judgement unit 5 (see col. 10, lines 10-26). Thus, while the data output unit 6 of Imai is able to output data, Appellants submit that Imai does not include any disclosure indicating that the data output unit 6 supplies received superdistribution format data to an external recording apparatus in a case where said data format judging means judges that the received data is of the superdistribution format.

F. Claim 45

Regarding claim 45, Appellants note that this claim is similar to claim 24 discussed above, but is written in means plus function format. In particular, claim 45 recites the feature of a charging means for executing a charging operation based on the charge condition of the attribute information.

As noted above, in item 22 on page 10 of the final Office Action, the Examiner takes the position that the functional portion of means plus function limitations does not need to be explicitly disclosed in the reference if the claimed structure, as disclosed in the reference, is inherently capable of performing the claimed usage.

For the reasons discussed above with respect to claim 43, Appellants disagree and submit that the prior art structure must perform the identical function recited in the means plus function limitation, and if the identical function is not performed, then the prior art cannot be considered anticipatory. Accordingly, as the Examiner has merely taken the position that the prior art structure of Imai is inherently capable of performing the function recited in claim 45, Appellants submit that the Examiner's rejection is clearly improper.

Further, in the final Office Action, Appellants note that the Examiner has taken the position that the copyright kernel 104 of Imai corresponds to the charging means as claimed (see final Office Action at page 4). As noted above, however, the copyright kernel 104 of Imai is responsible for authenticating the application program 106 by determining whether it is a registered application program or not (see col. 18, lines 18-20). Appellants submit that

there is absolutely no disclosure whatsoever in Imai regarding the copyright kernel 104 executing a charge operation based on a charge condition of the attribute information, as recited in claim 45.

II. Conclusion

For the reasons set forth above, it is submitted that Imai et al. does not disclose each and every limitation of claims 22-24, 26-28 and 43-48. Accordingly, as the applied prior art does not teach every limitation set forth in the claims, Appellants submit that the anticipation rejection based on Imai is improper. See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In view of the foregoing, Appellants submit that claims 22-24, 26-28 and 43-48 are allowable over the prior art of record, and respectfully submit that the Examiner's decision to finally reject claims 22-24, 26-28 and 43-48 should be reversed.

Respectfully submitted,

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CLAIMS APPENDIX - claims on appeal

22. A data conversion apparatus for use with an external recording apparatus and an external equipment, and for use in converting data including audio contents to superdistribution format data and outputting the superdistribution format data to be supplied to the external recording apparatus to be recorded therein,

said superdistribution format data including said audio contents and attribute information which represents at least a charge condition permitting creation of a copy of the audio contents, and including identification information identifying a user of the data conversion apparatus,

said data conversion apparatus comprising:

a data transmission/receiving section for transmitting and receiving data to and from the external equipment;

a data format judging section for judging whether or not data received by said data transmission/receiving section is of a superdistribution format;

an attribute information obtaining section for identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via said data transmission/receiving section;

a user ID storage section storing the identification information identifying the user of the data conversion apparatus;

a ciphering section ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage section;

a data format conversion section adding said ciphered attribute information and identification information to the audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution data format; and

a controller for controlling said data transmission/receiving section, data format judging section, attribute information obtaining section and data format conversion section,

wherein, in a case where said data format judging section judges that the received data is not of the superdistribution format, said controller controls said attribute information obtaining section so as to obtain the attribute information corresponding to the audio contents from the external equipment, and wherein said controller controls said data format conversion section so as to convert the audio contents of the received data together with the obtained attribute information into the superdistribution format data, so that the resultant data converted to the superdistribution data format is outputted and supplied to the external recording apparatus,

wherein said data transmission/receiving section includes a data read-out portion for reading the data out of a disc medium recorded with the data containing the audio contents and includes a network interface which receives the attribute information corresponding to the audio contents from an external server via a digital network, and

wherein said attribute information obtaining section obtains identification information read out of the disc medium and transmits the obtained information to the external server via the digital network and receives attribute information corresponding to the audio contents recorded in the disc medium identified by the identification information from the external server.

23. The data conversion apparatus as claimed in claim 22 further comprising a data outputting section, wherein in a case where said data format judging section judges that the received data is of the superdistribution format, said controller controls said data outputting section so as to supply the received superdistribution format data to the external recording apparatus.

24. The data conversion apparatus as claimed in claim 23 further comprising: a recording section for recording the superdistribution format data; and

a charging section for executing a charging operation based on the charge condition of the attribute information,

wherein said controller controls said charging section so as to execute the charging operation of the superdistribution format data based on the charge condition of the attribute information when a copy of the superdistribution format data read out of said recording section is supplied to the external recording apparatus to be recorded therein.

26. The data conversion apparatus as claimed in claim 22, wherein said attribute information obtaining section obtains the identification information of the disc medium by way of a user direct input operation.

27. The data conversion apparatus as claimed in claim 22, wherein said attribute information obtaining section obtains the identification information of the disc medium by

extracting the number of pieces and reproduction time of the audio contents recorded in the disc medium.

28. The data conversion apparatus as claimed in claim 22, for use with an external charging device, wherein said network interface is connected to the external charging device via the digital network so that said charging section executes the charging operation based on the charge information in cooperation with the external charging device.

43. A data conversion apparatus for use with an external recording apparatus and an external equipment, and for use in converting data including audio contents to superdistribution format data and outputting the superdistribution format data to be supplied to the external recording apparatus to be recorded therein,

said superdistribution format data including said audio contents and attribute information which represents at least a charge condition permitting creation of a copy of the audio contents, and including identification information identifying a user of the data conversion apparatus,

said data conversion apparatus comprising:

a data transmission/receiving means for transmitting and receiving data to and from the external equipment;

a data format judging means for judging whether or not data received by said data transmission/receiving means is of a superdistribution format;

an attribute information obtaining means for identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via said data transmission/receiving means;

a user ID storage means for storing the identification information identifying the user of the data conversion apparatus;

a ciphering means for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means;

a data format conversion means for adding said ciphered attribute information and identification information to the audio contents and thereby converting the audio contents together with the obtained attribute information to the superdistribution data format; and

a controlling means for controlling said data transmission/receiving means, data format judging means, attribute information obtaining means and data format conversion means,

wherein, in a case where said data format judging means judges that the received data is not of the superdistribution format, said controlling means controls said attribute information obtaining means so as to obtain the attribute information corresponding to the audio contents from the external equipment, and wherein said controlling means controls said data format conversion means so as to convert the audio contents of the received data together with the obtained attribute information into the superdistribution format data, so that the resultant data converted to the superdistribution data format is outputted and supplied to the external recording apparatus,

wherein said data transmission/receiving means includes a data read-out portion for reading the data out of a disc medium recorded with the data containing the audio contents

and includes a network interface which receives the attribute information corresponding to the audio contents from an external server via a digital network, and

wherein said attribute information obtaining means obtains identification information read out of the disc medium and transmits the obtained information to the external server via the digital network and receives attribute information corresponding to the audio contents recorded in the disc medium identified by the identification information from the external server.

44. The data conversion apparatus as claimed in claim 43, further comprising:

a data outputting means, wherein in a case where said data format judging means judges that the received data is of the superdistribution format, said controlling means controls said data outputting means so as to supply the received superdistribution format data to the external recording apparatus.

45. The data conversion apparatus as claimed in claim 44, further comprising:

a recording means for recording the superdistribution format data; and
a charging means for executing a charging operation based on the charge condition of the attribute information,

wherein said controlling means controls said charging means so as to execute the charging operation of the superdistribution format data based on the charge condition of the attribute information when a copy of the superdistribution format data read out of said recording means is supplied to the external recording apparatus to be recorded therein.

46. The data conversion apparatus as claimed in claim 43, wherein said attribute information obtaining means obtains the identification information of the disc medium by way of a user direct input operation.

47. The data conversion apparatus as claimed in claim 43, wherein said attribute information obtaining means obtains the identification information of the disc medium by extracting the number of pieces and reproduction time of the audio contents recorded in the disc medium.

48. The data conversion apparatus as claimed in claim 43, for use with an external charging device, wherein said network interface is connected to the external charging device via the digital network so that said charging means executes the charging operation based on the charge information in cooperation with the external charging device.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None